



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,873	01/19/2001	Hongsheng Su	104385.132	9057
23483	7590	11/19/2003	EXAMINER	
HALE AND DORR, LLP			HUTSON, RICHARD G	
60 STATE STREET				
BOSTON, MA 02109			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/766,873	Applicant(s) SU ET AL.
	Examiner Richard G Hutson	Art Unit 1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 4 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-22, 26 and 30-35.

Claim(s) withdrawn from consideration: 23-25 and 27-29.

8. The proposed drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.
9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. Other: _____



Richard G Hutson, Ph.D.
Primary Examiner
Art Unit: 1652

Continuation of 2. NOTE: Applicants proposed amendment of claim 1 which limits the recombinant DNA to the coding sequences for a number of heparinase gene and a selectable marker, if entered would result in an additional 112 second paragraph rejection of claims 9 and 10 which are dependent on claim 1 but further limit claim 1 such that the host cell further comprises a selective marker for host cell selection. Claim 10 further limits the selective marker resulting in confusion as to which marker is being limited, "the selective marker", or the "selectable marker".

Continuation of 5. does NOT place the application in condition for allowance because: The rejections of record remain based on the non entry of applicants proposed amendment. Specifically:

Claims 1-22, 26 and 30-35 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-22, 26 and 30-35 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a *Flavobacterium heparinum* transformed with pIBFX1 and pIBFX2, does not reasonably provide enablement for a *Flavobacterium heparinum* transformed with any vector

Claims 1-11, 13-21, 26 and 30-35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman et al. (WO 96/01894, January 25, 1996) and McBride et al. (Applied and Environmental Microbiology, Vol. 62, No. 8, pages 3017-3022, August 1996).